IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:		Atty. Docket No.:	007287.00043
Dan Kikinis *et al.*			
Serial No.:	09/661,164	Group Art Unit:	2424
Filed:	September 13, 2000	Examiner:	Joseph G. Ustaris
For:	SYSTEM AND METHOD FOR INSERTION OF RECORDED MEDIA INTO A BROADCAST	Confirmation No.:	7516

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Box AF
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Final Office Action dated December 2, 2008, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on Reynolds *et al.* (U.S. Patent Pub. No. 2001/0037500, "Reynolds"), Gordon *et al.* (U.S. Patent Pub. No. 2001/0014975,

"Gordon") and Zigmond *et al.* (U.S. Patent No. 6,698,020, "Zigmond") in its rejection of claims 1-6, 9-16, 18, 26-31, 33 and 34 as argued in Applicant's Amendment and Response dated October 20, 2008, at pp. 7 and 8. Claims 1, 11 and 26 recite, *inter alia*, a set-top box receiving media separate from a broadcast stream, the media having a second priority indicator greater than a first priority indicator of the broadcast stream, receiving a signal configured to modify the first priority indicator from a first priority to a second priority, and modifying the first priority indicator from the first priority to the second priority in response to receiving the signal. As Applicants noted previously, Gordon describes that it is the local servers, not the set-top boxes, that have intelligence to resolve conflicts and to assign different priorities as necessary. p. 4, paras. [0063]-[0065]. The Final Office Action dated December, 2, 2008 asserts at p. 3 that "Gordon does disclose a process/method (e.g. changing priorities in response to a received signal) that is well known in the art and are used to perform functions that are also well known in the art (e.g. changing priorities). Therefore, one of ordinary skill would recognize that such a process/method could be placed in various embodiments (e.g. in a local server or in a set-top box) and still would produce a predictable result (e.g. producing changing priorities in response to a received signal)." The mere fact that a combination would result in a predictable result (which Applicants do not concede) amounts to a mere conclusory statement and does not satisfy the obviousness inquiry. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (cited with approval in *KSR*). Here, the Office Action has not provided any articulated reasoning or analysis to support its conclusion of obviousness. For example, the Office Action fails to provide a reason why one of ordinary skill in the art would place the intelligence for resolving priority conflicts (as discussed in Gordon) in the set-top box receivers of the Gordon system. Indeed, Applicants submit that it would not have been obvious to combine the references in the asserted manner because the purpose of Gordon is to alleviate bandwidth and storage requirements

of an interactive television network by using local servers to resolve priority conflicts and to store subsets of data objects. *See*, *e.g.*, para. [0011]. Placing such a burden on the set-top boxes in Gordon would reduce the efficiencies sought by using the local servers to perform such tasks. Accordingly, the above claims are allowable for at least these reasons.

- Furthermore, claim 38 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Gordon, Zigmond and Robinett *et al.* (U.S. Patent No. 6,351,474, "Robinett"). Claim 38 recites, *inter alia*, "determine that the first priority indicator is greater than the second priority indicator prior to receiving the signal; and delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified." Nowhere does Robinett teach or suggest that the insertion of the separate media is delayed until the first priority indicator is modified. As noted previously, not only does the PMT and CAT fail to describe a priority indicator, Robinett does not teach or suggest that insertion is delayed until the PMT or CAT is modified. In response to Applicants' remarks, the Final Office Action asserts that "the insertion is not only based on the output, but also on the basis of the new version (or modified) of the PMT or CAT (See Robinett col. 32 line 56 - col. 33 line 7)." Robinett clearly states that any changes to PID mapping are preferably delayed until a new version of the PMT can be ***outputted*** in the TS. Col. 32, line 67 – Col. 33, line 4. Outputting does not constitute modifying. The Final Office Action's assertion does not argue that insertion of the separate media is delayed until the first priority indicator is modified, but merely that the insertion is "on the basis of" the new version of the PMT or CAT. Accordingly, claim 38 is allowable for this additional reason.
- Further, the Office Action appears to analogize the delay of the insertion of the separate media into a broadcast stream until the first priority indicator is modified to delaying an insertion of a changed PID mapping until a new/modified version of the PMT or CAT is available. Even assuming that Robinett describes delaying the insertion of a changed PID mapping and that Reynolds describes the insertion of separate media, the Office fails to provide any type of reasoning why one of

ordinary skill in the art would combine Robinett and Reynolds in such a manner. At most, the Office Action states that such one of ordinary skill would combine the references in such a manner to insure that all changes are made and properly recorded. However, Robinett relates to insertion of PIDs, not separate media. Accordingly, the Office Action's rationale would not apply to the insertion of separate media. Claim 38 is thus allowable for this additional reason.

While Applicants believe that the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

Conclusion

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3156.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: March 2, 2009

By: /Chunhsi Andy Mu/

Chunhsi Andy Mu, Reg. No. 58,216
1100 13th Street, N.W.
Washington, D.C. 20005
Tel: (202) 824-3000
Fax: (202) 824-3001